

made," is attached hereto. Since this Amendment does not increase either the total number of claims or the number of independent claims, no additional fee is necessary.

Claims 1 - 7 are in the application. No claim has been allowed.

It is respectfully submitted that all the claims remaining in the application, including claim 3 as herein amended, are now clearly entitled to the priority benefit of Japanese patent application No. 2000-133980. See the Advisory Action at p. 2, line 1, to p. 3, line 3. Therefore, Japanese Patent 2000-199982 (JP '982) is not prior art to any claim now in the application.

It is applicants' understanding that their previously submitted First Reply to Final Rejection mailed March 27, 2003, and the accompanying certified translation of their aforesaid Japanese Patent Application No. 2000-133980, have been entered; if not, it is hereby requested that those submissions be entered now.

Applicants again submit that claim 1, and claims 2, 3 (as herein amended), 4, 5, 6 and 7, all dependent on claim 1, distinguish patentably over the applied references, however combined, for the reasons set forth in their aforesaid First Reply to Final Rejection mailed March 27, 2003, viz., that even assuming arguendo that claim 1 is prima facie obvious over one or more of the combinations of references (excluding JP '982) asserted in the final Office Action, nevertheless the claimed novel combination of method features achieves an unobvious and unexpected beneficial result that is entitled to patentable weight.

In particular, applicants observe that JP '982 cannot be relied on to show that "the results in the specification do not appear to be unexpected" since, with the amendment of claim 3, and the cancellation of claims 8 - 11, 23 and 24 herein, JP '982 is not prior art as to any claim. Compare the last paragraph on p. 5 of the Advisory Action.

The Examiner has indeed asserted that the showing of unexpected results in the Examples and Comparative Examples in applicants' specification "is not commensurate in scope with the instant claims because instant examples 1-4 comprise combinations of preferred embodiments recited in dependent claims 2-7, which are not recited in" claim 1 (Advisory Action, p. 4). These "preferred embodiments" are

"a haze factor not greater than 20%" (claim 2);

"a melt viscosity not greater than 120 mPas•sec"
(claim 3);

"a polyol resin..." as binder (claim 4);

the polyol resin comprises "a reaction product of:
(a)...; (b)...; and either (c)... or (c')..."
(claim 5);

"an aromatic hydroxycarboxylic acid metal salt"
(claim 6);

"the metal" of the salt "is zinc" (claim 7).

Insofar as these "preferred embodiments" are present in the four Examples of the invention set forth in applicants' specification, however, they are also present in the three Comparative Examples of the specification. Comparative Example 1 differs from Example 1 only in the order of toner layers (i.e., in Comparative Example 1, the yellow layer is formed on the magenta or cyan layer in the red and green images). Comparative Example 2 differs from Example 1 only in replacing the yellow and magenta pigments with those of Toner Manufacturing Example 5, which had haze factors within the limit of claim 2 and melt viscosities within the limit of claim 3. The black toner of Comparative Example 2 was identical to that of Example 1, containing a salt as defined in claims 6 and 7; the cyan toner was also identical, and the same resins were used in all the toners of both Example 1 and Comparative Example

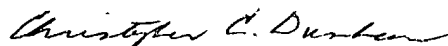
2. Like correspondences and differences existed between Comparative Example 3 and Example 2.

Thus, the Comparative Examples in the specification differed from the Examples of the claimed invention in the specification essentially only with respect to the order of toner layers or the yellow and magenta pigments used (all of which are features recited in claim 1), and not with respect to the presence or absence of any of the "preferred embodiment" features of claims 2 - 7. The Examples met all the limitations of claim 1; the Comparative Examples did not.

Since all factors other than features of claim 1 were thus effectively unchanged as between the Examples and Comparative Examples, it is submitted that the data in the specification fairly establish that the improved results are obtained from the combination of pigments and layer order recited in claim 1. Consequently, the showing of unexpected beneficial results in the specification is properly commensurate in scope with claim 1.


For the foregoing reasons, it is believed that claim 1, and claim 2 - 7 dependent thereon, are allowable. Favorable action thereon is accordingly courteously requested.

Respectfully,



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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


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Reg. No. 22,031 Date MAY 29, 2003

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 3 has been amended as follows:

3. (Amended) The method according to Claim 1, wherein the color toners have a melt viscosity not greater than [about] 120 mPas•sec at 140°C.